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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,674	08/07/2003	Tohru Hashioka	10404/16	1782

7590 02/28/2005

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LD

## Office Action Summary

Application No.

10/635,674

Applicant(s)

HASHIOKA ET AL.

Examiner

D. S. NAKARANI

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/16/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

(1). The disclosure is objected to because of the following informalities: Page 15, line 21, the word "sometimves" should read - - sometime - -. Applicants are requested to review entire application for additional errors.

Appropriate correction is required.

(2). The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(3). Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a petroleum resin having softening point from 110<sup>0</sup>C to 150<sup>0</sup>C and present in an amount of 5 to 40 wt% based on a blend of propylene base resin and petroleum resin (see page 12, lines 11-21 and page 15, lines 8-23), does not reasonably provide enablement for petroleum resin having softening point less than 110<sup>0</sup>C and amount less than 5 wt% and higher than 40 wt%. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The invention as claimed reads on any petroleum resin and in an amount little less than 99 wt%. There is no evidence showing that e.g. 99 wt. part of mixture comprising (A) 1 wt% polypropylene base resin and (B) 99 wt% petroleum resin will result in claimed heat shrinkable polyolefin base film.

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- (4). The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- (5). Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 depends from claim 6 which requires an outer layer comprising a styrene resin and a polyolefin resin. Therefore limitation "said outer layer comprises 40 to 100 parts by weight of a styrene resin and 60 to 0 parts by weight of a propylene- $\alpha$ -olefin random copolymer" in claim 7 renders claims confusing because when the outer layer has 100 parts by weight of a styrene resin, there is no presence of a polyolefin resin which is required by claim 6.

- (6). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- (7). Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer et al (U.S. Patent 5,573,717).

Peiffer et al disclose an oriented polyolefin film comprising propylene based resin, amorphous polymer having glass transition temperature from 70°C to 300°C and petroleum resin

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having softening point between 60<sup>0</sup>C and 180<sup>0</sup>C (col. 4, lines 37-54, col. 5, line 60 to col. 6, line 5 and col. 9 lines 22-47). Peiffer et al also disclose density of film in the range from 0.4 to 1.5 g/cm<sup>3</sup> (col. 7 lines 12-20). Peiffer et al also disclose density of film in the range from 0,4 to 1.5 g/cm<sup>3</sup> (col. 7 lines 12-20). Peiffer et al disclose an amorphous polymer such polycyclic olefin (col. 6 lines 3-4). Peiffer et al's disclosed amounts of petroleum resin and a cyclic polyolefin encompass claimed amounts. Peiffer et al's disclosed glass transition temperature range from 70<sup>0</sup>C to 300<sup>0</sup>C encompasses claimed glass transition temperature range 90<sup>0</sup>C to less than 140<sup>0</sup>C. Peiffer et al fail to disclose claimed thermal shrinkage.

However given the teaching of Peiffer et al a person of ordinary skill in the art at the time of this invention made would have found it obvious to optimize thermal shrinkage by varying thermofixing temperature or by eliminating thermofixing step. In an oriented polyolefin film art, a person of ordinary skill in the art is knows how to control shrinkage at a given temperature.

(8). Claims 6-12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

(9) Receipt of Information Disclosure Statement filed January 16, 2004 is acknowledged. All non-English documents have been considered to the extent of provided an English language abstract. All documents except JP 01-245350 A have been made of record. The document JP 01-245350 A has been crossed – out since this document is directed to a WAIT CONTROL SYSTEM and not to a heat shrinkable polyolefin base film. If applicants are desirous to make this document of record, relevance of this document to this application should be provided.

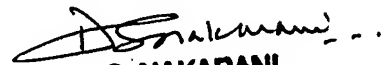
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(10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday thru Fridays from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nakarani/LR  
February 11, 2005

  
**D. S. NAKARANI**  
**PRIMARY EXAMINER**